The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte GORDON R. MEYER, ALBERT R. HOWARD, JR., KEVIN KNABE and RICHARD B. HOIBERG

Appeal No. 2002-0634
Application 09/074,544

ON BRIEF

Before THOMAS, HAIRSTON and BARRY, Administrative Patent Judges.

THOMAS, Administrative Patent Judge.

REMAND TO THE EXAMINER

Appellants have appealed to the Board from the examiner's final rejection of claims 1-61.

Representative claims 1 and 2 are reproduced below:

1. A method for displaying information to a user of a computer system, comprising the steps of:

activating a computerized information system;

dynamically generating a table of contents in response to said activation; and

displaying said dynamically generated table of contents;

wherein said computer system displays an up-to-date listing of available information.

2. The method according to claim 1 wherein the step of dynamically generating comprises the steps of:

indexing each file and book of a predetermined folder for files of a first type; and

scanning said files of a first type for at least one HTML meta-tag of a predetermined type in order to determine data to be added to said table of contents.

The following references are relied on by the examiner:

Walls et al. (Walls)	5,848,410	Dec. 8, 1998 (filing date Oct. 8, 1997)
DeRose et al. (DeRose)	6,055,544	Apr. 25, 2000 (effective filing date Mar. 15, 1996)

Claims 6-15, 29-38 and 46-59 stand rejected under 35 U.S.C. § 102(e) as being anticipated by DeRose. Claims 2-5, 16-23, 25-28, 39-45, 60 and 61 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner relies upon DeRose in view of Walls. As stated at pages 2 and 3 of the brief, and at the top of page 1 of the claims attached to the brief, appellants withdraw the appeal as to claims 1 and 24. This results in the examiner's statement of the rejection under 35 U.S.C. § 103 beginning with claim 2 and 25 rather than respective claims 1

and 24. As a result of appellants' withdrawal of the appeal as to claims 1 and 24, the appeal as to them is dismissed. For the sake of convenience, we have reproduced claims 1 and 2 earlier in this opinion.

Rather than repeat the positions of the appellants and the examiner, reference is made to the brief (filed on August 17, 2001) and reply brief as to appellants' positions, and to the first action, final rejection and answer as to the examiner's positions.

OPINION

As a result of our review of the record of the appeal before us, we remand this application to the examiner for a coherent statement of the rejections in one document. At the bottom of page 3 of the answer, the examiner makes reference to the statement of both rejections of the claims on appeal as set forth in the prior Office action Paper No. 8, which is the final rejection. Pages 2 and 3 of the final rejection, in turn, make reference to and rely on the previous statements of the rejections in the first Office action, which is Paper No. 6.

This file history clearly indicates that the final rejection does not by itself completely explain the examiner's reasoning

for the two stated rejections of the claims on appeal. The examiner's indirect reference and reliance upon another prior Office action other than the final rejection violates MPEP § 1208, Topic A, which permits the examiner to rely upon only a single Office action for a statement of the rejection and instructs the examiner to avoid indirect references to other Office actions.

Moreover, the examiner's responsive arguments set forth beginning at page 4 of the final rejection significantly expand upon the examiner's reasoning set forth in the earlier stated, improperly incorporated by reference, first Office action in Paper No. 6. In like fashion, the answer itself significantly expands upon the examiner's reasoning of the rejection in response to those arguments presented in the principal brief on appeal.

In view of this overall scenario, we are significantly burdened in trying to assess the examiner's position set forth among two prior Office actions as well as the answer. Within 37 CFR § 1.196(a) as well as MPEP § 1211, this application is remanded to the examiner to formulate a coherent statement in a supplemental answer of the examiner's statements of the rejections as to all claims on appeal. Correspondingly,

appellants are free to express their positions with respect to the new statements of the rejection by the examiner in any single, responsive brief.

From our study of the record before us, we make the following notes in passing for the benefit of the examiner and the appellants.

Initially, because the nature of the subject matter set forth in independent claims 1 and 24 on appeal is substantially identical to the subject matter set forth in independent claim 18 and independent claim 41, it appears to us that a corresponding basis exists for appellants to withdraw the appeal as to claims 18 and 41 for the same reasons they did with respect to claims 1 and 24. Correspondingly, the subject matter of dependent claims 20 and 42, appears to correspond to the subject matter of dependent claims 2 and 25. For purposes of consistency, it appears that they should all be treated the same.

The Background of the Invention at specification pages 1 and 2 sets forth a brief statement of prior art approaches where HTML links are hard-coded or otherwise static and not subject to being updated, which is reflective of appellants' invention in the Summary of the Invention beginning at page 2 of the specification as filed. Correspondingly, the bottom of column 1 of DeRose

indicates that prior art HTML documents were known to be stored in a generally static fashion where the contents did not change over time unless the publisher modified the document. According to the discussion at the end of the Summary of the Invention at column 5, line 54 through the end of the Summary at the top of column 6, it appears that one of the overall contexts of DeRose's invention is to permit the ability of prior art fixed documents to be modified or otherwise edited in a rather simplified fashion when new tags are therefore added to prior art HTML mark-up language versions of these documents. This type of modification is contemplated implicitly throughout the discussion of DeRose and is again summarized at column 21 beginning at line 40 through the end of the patent. Thus, it is apparent that the context in which DeRose is implemented is similar in context to that which appellants' contribution in the art is over the admitted prior art at specification pages 1 and 2. This has not been realized or developed by the examiner.

Whereas DeRose details various table of content approaches to updating documents to modify them, the necessary indexing to accomplish this is minimally disclosed in DeRose as compared to the details of the actual indexing being more specifically set forth in Walls for periodically updating corresponding so-called

meta-tags which are discussed in both references. The discussion of these meta-tag files in the prior art is detailed beginning at the bottom of column 14 of Walls in a manner corresponding to the discussion of them at page 10 of the appellants' specification as filed. The use of these tags in mark-up languages in DeRose is detailed throughout the reference as well.

These observations appear significant in the sense that the subject matter of independent claim 1 alone with its dependent claim 2 (rejected under 35 U.S.C. § 103) corresponds very closely to the subject matter of independent claim 6 (rejected under 35 U.S.C. § 102). These claims are representative of the basic concepts argued of dynamically generating new tables of contents to provide an up-to-date listing of available information in the manner specifically using indexing and scanning of HTML meta-tags to provide new or added information to the table of contents.

It is believed that these remarks would significantly aid the examiner and appellants in formulating any revised rejections and positions with respect to the subject matter of the claims on appeal in accordance with this remand.

It is important that the Board of Patent Appeals and Interferences be informed promptly of any action affecting the status of the appeal (i.e., abandonment, issue, reopening prosecution).

REMANDED

James D. Thomas
Administrative Patent Judge

Kenneth W. Hairston
Administrative Patent Judge

Lance Leonard Barry
Administrative Patent Judge

) BOARD OF PATENT APPEALS AND INTERFERENCES

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